



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,079	04/10/2001	Robert Smart	169.2021	7417
5514	7590	11/02/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			SON, LINH L D	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2135	
DATE MAILED: 11/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/829,079	<b>Applicant(s)</b> SMART ET AL.	
	<b>Examiner</b> Linh LD Son	<b>Art Unit</b> 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is responding to the RCE filed on 08/08/05.
2. Claims 1-14 are pending. Claims 9-14 are newly added claims.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al, US/5633932, hereinafter "Davis".

5. As per claims 1 and 2:

Davis discloses "A method of conducting, in relation to a print job, a printing process between an originating device and a printer, said method-comprising steps of: Inputting security key information specific to the print job to the originating device" in (Col 4 lines 39-67); "Embodying corresponding print job specific security key information in a physical security key" in (Col 4 lines 50-65, and Col 6 lines 20-33); "initiating, in association with the print job specific security key information, the printing process at the originating device for outputting the print job from the printer; suspending the

Art Unit: 2135

printing process prior to outputting the print job from the printer” in (Col 5 lines 1-25, and lines 15-20); input, using the physical security key via a local user interface at the printer, the corresponding print job specific security key information; and enabling, depending upon the corresponding print job specific security key information, the suspended printing process to output the print job from the printer” in (Col 5 lines 34-65).

6. As per claims 3 and 6:

Davis discloses “A method according to claims 1 and 4, wherein the corresponding print job specific security key information is one of a) complementary to the print job specific security key information and b) identical to the print job specific security key information” in (Col 4 lines 39-55)

7. As per claim 4:

Davis discloses “A system for conducting a secure printing process, in relation to a print job, between an originating device and a printer, wherein the originating device and the printer communicate over a network, said system comprising: a security key interface (Col 5 lines 50-65), adapted to input security key information specific to the print job to the originating device; a physical security key, embodying corresponding print job specific security key information” in (Col 4 lines 50-65, and Col 6 lines 20-33); “a user interface, adapted to initiate, in association with the print job specific security key information, the printing process at the originating device for outputting the print job from the printer” in (Col 5 lines 50-65); “at least one processor module, adapted to suspend

Art Unit: 2135

the printing process prior to outputting the print job from the printer” in (Col 5 lines 13-25); and “a local user interface at the printer, adapted to enable input of the corresponding print job specific security key information, wherein said at least one processor module is adapted to enable, depending upon the corresponding print job specific security key information, the suspended printing process to output the print job from the printer” in (Col 5 lines 34-65).

8. As per claim 5:

Davis discloses “A system according to claim 4, wherein the print job specific security key information is input via a local user interface at a computer communicating with the originating device over a network, wherein the image data is stored at the originating device” in (Col 1 lines 30-55, and Col 4 lines 23-37).

9. As per claim 7:

Davis discloses “A computer program recorded on a computer-readable medium, the program comprising software code portions for performing the steps of claim 1” in (Col 3 lines 30-35).

10. As per claim 8:

Davis discloses “A computer readable medium storing a computer program, wherein said computer program comprises software code portions for performing the steps of claim 1” in (Col 4 lines 1-5).

Art Unit: 2135

11. As per claims 9 and 12:

Davis discloses "A printing method comprising the steps of:

Inputting at an originating device, public key information that corresponds to private key information" in (Col 4 lines 39-56); "initiating, depending upon the public key information input at the originating device, a printing process for printing image data on a printer" in (Col 4 lines 39-65, and Col 6 lines 5-33); "suspending the printing process prior to printing image data on the printer" in (Col 5 lines 15-20); "inputting the private key information at the printer; and enabling, depending upon the private key information input at the printer, the suspended printing process to print the image data on the printer" in (Col 5 lines 50-65).

12. As per claims 10 and 13:

Davis discloses "A system according to claims 9 and 12, wherein the print job specific security key information is input via a local user interface at a computer communicating with the originating device over a network" in (Col 4 lines 39-55, Col 6 lines 52-65, and Col 6 lines 20-33), wherein the image data is stored at the originating device" in (Col 1 lines 30-55, and Col 4 lines 23-37).

13. As per claims 11 and 14:

Davis discloses "A method according to claim 9, wherein said step of initiating includes a step of encrypting, at the originating device, the image data using the public key information and a step of sending the encrypted image data from the originating device to the printer" in (Col 4 lines 39-55, Col 6 lines 52-65, and Col 6 lines 20-33), and

Art Unit: 2135


said step of enabling includes a step of decrypting, at the printer, the encrypted image data using the private key information and a step of printing the decrypted image data on the printer" in (Col 5 lines 20-25).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh LD Son whose telephone number is 571-272-3856. The examiner can normally be reached on 9-6 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh LD Son  
Examiner  
Art Unit 2135

  
Primary Examiner  
Art Unit 2135